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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/832,503

04/11/2001

Thomas E. Benim

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07/12/2005

EXAMINER

RHEE, JANE J

E I DU PONT DE NEMOURS AND COMPANY  
LEGAL PATENT RECORDS CENTER  
BARLEY MILL PLAZA 25/1128  
4417 LANCASTER PIKE  
WILMINGTON, DE 19805

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/832,503

Applicant(s)

BENIM ET AL.

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 11, 18-32, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11, 18-32, 34-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/2005 has been entered.

### ***Rejections Repeated***

2. The 35 U.S.C. 103(a) rejection of claims 27-30 over Tollette in view of Keiser has been repeated as previously made in office action 8/25/2004.
3. The 35 U.S.C. 103(a) rejection of claims 34-35 over Tollette in view of McFall et al. has been repeated as previously made in office action 8/25/2004.
4. The 35 U.S.C. 102(b) rejection of claims 1-2,4,6-8,11,18-19,21-24,27-28,31-32 anticipated by Tollette has been repeated for the reasons previously made in paper 3/14/2005.

As to claim 11, Tollette discloses that the face material comprises paper (figure 2 number 18) or thermoplastic film comprising polyester, polyethylene or polypropylene (figure 2 number 12 col. 3 lines 8-15)

As to claim 22, the negative limitation "wherein the another face material is not a release backing sheet" is considered new matter because the specification has no support for the new limitation. Any negative limitation or exclusionary proviso must

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have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

As to claim 31, Tollette discloses an insulating label stock comprising a thermal insulating layer (figure 1 number 22) having a thickness in the range of 0.00025-.025 inches which is at least 0.0075 inch (0.190 cm) (col. 2 lines 65-67) as claimed by applicant, wherein the label stock has a face material (figure 2 number 12), a top edge (figure 3 number 63) a lower bottom edge (figure 3 bottom of label),, and the face material is film (figure 2 number 12 col. 3 lines 8-15) and two sheets of face material are sealed together along the top, bottom and side edges (figure 5 number 42,52).

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5. The 35 U.S.C. 103(a) rejection of claim 3 over Tollette in view of Keiser repeated for the reasons previously made in paper 3/14/2005.
6. The 35 U.S.C. 103(a) rejection of claim 20 over Tollette in view of Yamada et al. repeated for the reasons previously made in paper 3/14/2005.
7. The 35 U.S.C. 103(a) rejection of claims 25-26,29-30 over Tollette in view of McFall et al. repeated for the reasons previously made in paper 3/14/2005.
8. The 35 U.S.C. 103(a) rejection of claims 34-35 over Tollette in view of McFall et al. repeated for the reasons previously made in paper 3/14/2005.

***New Rejection***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter issue is "wherein the another face material is not a release backing sheet". The new matter is not described nor disclosed in the specification.

***Response to Arguments***

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11. Applicant's arguments filed 5/13/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the film can not be the face material since it does not laminate to the insulating layer, the film is the face material because it does laminate to the insulating layer however does not directly laminate to the insulating layer. Applicant merely claimed that the insulating layer is laminated to at least one sheet of face material which the insulating layer of Tollette is laminated to a face material as shown in figure 2 numbers 22 and 12).

In response to applicant's argument that that paper does not melt and as a consequence has no melting temperature, due to applicant's current amendment, the face material now can be considered either the film in figure 2 number 12 and the adhesive layer 14 or adhesive layer 14 and adhesive layer 20 and since the second layer and first layer are made from two different materials, the second layer inherently has a lower melting temperature than the first layer.

In response to applicant's argument that the face material is required to be film not comprise film, which distinguishes over Tollette, Tollette does disclose that the face material is film in figure 2 number 12 or number 20 which is a film of adhesive.

In response to applicant's argument that the film disclosed by Tollette does not laminate to the insulating layer, in figure 2 number 20, the adhesive film is laminated to the insulating layer 22. The face material can be considered numbers 14,18,20 wherein layers 14,18,20 are all laminated to the insulating layer 22.

In response to applicant's argument that the mere presence of the ink layer in Tollette does not anticipate that a printable coating is present on the face material because ink is not a coating, Webster defines "coating" as to cover or spread with a finishing, protecting, or enclosing layer, therefore the ink "layer" in Tollettes does anticipate a printable coating is present on the face material since a coating is a layer as defined by Webster.

In response to applicant's argument that Tollette discloses that the ink is applied to the underside of the film prior to adhesion to the layer 18 therefore layer 18 does not facilitate printing for printing is not on layer 18, the limitation "to facilitate printing thereon" is an intended use. It has been held that a recitation with respect to the manner in which the claimed particle is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicant's argument that Tollette fail to disclose face material does not facilitate bonding to another surface with adhesive because the adhesive layer 14 is applied to the underside of film layer 12, the limitation "to facilitate bonding to another surface with an adhesive" is an intended use. It has been held that a recitation with respect to the manner in which the claimed particle is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicant's argument that Examiner did not specifically reject claims 18-19, on pg 4, paragraph 1, specifically states the rejection for claims 18-19.

In response to applicant's argument that the Examiner ignored the limitation of the second layer in claim 21, applicant claims in claim 21 that the second layer is disposed between the thermal insulating layer and the first layer, Tollette discloses that the second layer number 20 is disposed between the thermal insulating layer number 22 and the first layer 14. Also the second layer could be number 14 which is disposed between the thermal insulating layer 22 and first layer 12.

In response to applicant's argument that applicant's submit that the releaseable backer is not a face material, applicant merely states in the specification that and adhesive primer is applied to the untreated surface of the face material and that a release liner may be provided on top of the adhesive primer, however does not suggest that the release liner in no way can be considered a face material. Applicant further states that the face material becomes the face of the label when the label is applied to a container, however in applicant's drawing there are two face materials on either side of the label, wherein in one of the face material is on the interior side of the label when applied to the container therefore would not be considered a face material if the face material becomes the face of the label when the label is applied to the container.

In response to applicant's argument that Tollette fail to disclose sealing along the edges of two sheets of face material, in figure 2 the two face materials 12,14 and 26,28 are sealed to the insulating layer through out the entire area of the layer as shown in the figure therefore, the two face materials inherently are sealed along the edges of the two sheets.

### ***Conclusion***



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee  
July 9, 2005



**PATRICK JOSEPH RYAN**  
**SUPERVISORY PATENT EXAMINER**